

**REMARKS****I. Status of Claims**

Claims 84-87 have been amended, and claims 1-83 and 88-102 have been withdrawn. After amending the claims as set forth above, claims 1-102 will be pending in this application.

Applicant respectfully requests reconsideration of the present application in view of the reasons that follow.

**II. Restriction Requirement**

While the examiner purports to withdraw the biomarker restriction and to treat applicant's designation of WM-477 a species election, which the examiner uses to examine claims 84-87, he asserts that "a search of all of the biomarkers would be a serious burden." To the extent the prior restriction is maintained, applicant reasserts the prior grounds of traversal. In addition, applicant notes that a review of each biomarker would not constitute a serious burden, as such a search would transpire in the context of the claimed invention, *i.e.* a method of qualifying lung carcinoma status, and not in a vacuum, as the examiner implies.

**III. Claim Rejections under 35 U.S.C. § 101**

The examiner rejects claims 84-87 for allegedly being directed to non-statutory subject matter. Yet, the examiner's stated rationale is insufficient to support a rejection under 35 U.S.C. § 101. Specifically, the Office Action concludes that "[t]he instant claims do not produce a useful, tangible and concrete final result." *See* Office Action at p. 3. However, the Federal Circuit has stated that "while looking for 'a useful, concrete and tangible result' may in many instances provide useful indications of whether a claim is drawn to a fundamental principle or a practical application of such a principle, that inquiry is insufficient to determine whether a claim is patent-eligible under § 101." *See In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (emphasis added).

Nevertheless, applicant has amended claims 84-87 to recite "a computer-readable medium" and believe the amendments obviate the rejection.

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Applicant believes that the present application is now in condition for allowance.  
Favorable reconsideration of the application as amended is respectfully requested.

The examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fee which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extension of time is needed for timely acceptance of papers submitted herewith, applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extension fee to Deposit Account No. 19-0741.

Respectfully submitted,

Date 18 September 2009 By S. A. Bent

FOLEY & LARDNER LLP  
Customer Number: 22428  
Telephone: (202) 672-5404  
Facsimile: (202) 672-5399

Stephen A. Bent  
Attorney for Applicant  
Registration No. 29,768